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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92059467
Party	Defendant Ubisoft Entertainment
Correspondence Address	JOEL D LEVITON STINSON LEONARD STREET LLP 150 SOUTH FIFTH STREET SUITE 2300 MINNEAPOLIS, MN 55402 UNITED STATES joel.leviton@stinsonleonard.com
Submission	Brief on Merits for Defendant
Filer's Name	Joel D. Leviton
Filer's e-mail	joel.leviton@stinson.com, trademark.mpl@stinson.com
Signature	/Joel D. Leviton/
Date	02/25/2016
Attachments	Ubisoft's Trial Brief.pdf(61414 bytes)

**UNITED STATES PATENT AND TRADEMARK OFFICE
TRADEMARK TRIAL AND APPEAL BOARD**

SST Records, Inc.,

Petitioner,

v.

Ubisoft Entertainment,

Registrant.

Cancellation No.: 92059467

REGISTRANT'S RESPONSE TO PETITIONER'S TRIAL BRIEF

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REGISTRANT’S RESPONSE TO PETITIONER’S TRIAL BRIEF

Petitioner SST Records, Inc. (“Petitioner”) has failed to satisfy its burden of proving likelihood of confusion. Other than similarity of the marks, there is no evidence demonstrating that the *DuPont* factors favor a finding of likelihood of confusion. The record lacks any evidence as to strength of Petitioner’s purported mark; there is no probative evidence as to similarity of the goods; there is no probative evidence as to similarity of the trade channels; and, notably, the record does not contain any evidence showing actual confusion, notwithstanding the fact that there has been ample opportunity for confusion (as confirmed by Petitioner’s own exhibits). Registrant Ubisoft Entertainment (“Ubisoft”) respectfully requests that the Petition to Cancel be dismissed, as Petitioner should not be entitled to obtain cancellation of a federal trademark registration on such a thin record.¹

¹ If Registrant’s brief is considered one day late, Registrant respectfully requests relief from the Board, as Registrant’s counsel believed that Registrant had five additional days to respond given service of Petitioner’s brief by First Class mail.

Background

Ubisoft owns Registration No. 4,516,085 for the mark BLACK FLAG in connection with the following goods:

- Game software and electronic game programs, namely, software games recorded on CD-ROM and digital video discs for computers;
- software games recorded on CD-ROM and digital video discs for console; and
- games that are downloadable from a remote computer site and electronic game software for mobile phones, personal digital assistants, and handheld computers.

Ubisoft uses its BLACK FLAG mark in connection with its ASSASSIN'S CREED trademark and the popular ASSASSIN'S CREED video game franchise. Ubisoft's Notice of Reliance, Exs. 2-12.

Petitioner petitioned to cancel Ubisoft's Registration No. 4,516,085. In doing so, Petitioner alleged ownership of Registration No. 4,549,987 and sought cancellation under Sections 2(a) and 2(d) of the Lanham Act.

Petitioner submitted with its Notice of Reliance what is claimed to be a printout of Petitioner's Application Serial No. 85/967,025 for the mark BLACK FLAG, which appears to have registered on September 1, 2015 under Registration No. 4,801,857. However, Petitioner did not claim ownership of or otherwise allege Application Serial No. 85/967,025 in its Petition to Cancel, and at no point did Petitioner move to amend its Petition to Cancel to assert 85/967,025 or the resulting Registration No. 4,801,857. Because Registration No. 4,801,857 has not been alleged in this proceeding it should not be considered in assessing the merits of Respondent's Petition to Cancel. Moreover, the filing date for Petitioner's Application Serial No. 85/967,025 (June 21, 2013) follows the filing date Ubisoft's application that resulted in Registration No. 4,516,085 (March 4, 2013). As such, even if Registration 4,801,857 is

considered to be asserted by Petitioner by virtue of Petitioner's inclusion of Application Serial No. 85/967,025 in its Notice of Reliance, Petitioner has not established priority with respect to the trademark that is the subject of Registration No. 4,801,857. Ubisoft respectfully request that Registration No. 4,801,857 not be considered in this proceeding.

As for the registration that Petitioner did assert, Registration No. 4,549,987, that registration covers:

- Audio and video recordings featuring music and artistic performances; and
- Entertainment, namely, live performances by a musical band.

Neither Petitioner nor Ubisoft engaged in any discovery in this proceeding. Nor did either party take or submit any testimony. Each party submitted a Notice of Reliance, the contents of which are outlined in Petitioner's Trial Brief at pages 3-5.

ARGUMENT

I. The Evidence of Record Does Not Establish Likelihood of Confusion.

Petitioner argues that similarity of the marks, similarity of the goods and services, and similarity of the trade channels are the most important *DuPont* factors in this case. Petitioner's br., p. 8. Ubisoft acknowledges that the marks at issue are identical for purposes of this cancellation proceeding, as the marks are considered as they appear in the registrations at issue. However, Petitioner overlooks critical factors that have a material impact on the likelihood of confusion analysis, particularly the strength of the Petitioner's mark and actual confusion. *In re E.I. du Pont de Nemours*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973).

a. There is no evidence demonstrating that Petitioner's mark is strong or even in use.

Petitioner did not take or submit any testimony pertaining to the length of time Petitioner's alleged mark has been used and any activities that might have been undertaken to

promote awareness of the mark. Petitioner claims its mark has been in use “[f]or nearly 30 years” (Petitioner’s br. at p. 10), but that statement is not supported by any probative evidence.

Petitioner would have the Board assume that its mark is strong enough to prevent the use of the same mark on what are admittedly non-competitive goods. Petitioner’s br., p. 10. But Petitioner has not offered reliable and probative evidence regarding the strength of its mark or consumer awareness of it. This proceeding is similar to *Sullivan III v. CBS Corp.*, 385 F.3d 772, 72 USPQ2d 1586 (7th Cir. 2004), in which the owner of the trademark SURVIVOR for the rock band with the hit “Eye of the Tiger” from the Movie Rocky III alleged that use of the SURVIVOR mark on soundtracks for the SURVIVOR television series constituted infringement. In affirming summary judgment for the defendants, the court held that the plaintiff did not establish that his mark was “famous enough to make consumers think the Series’ merchandise is likely to come from his band.” *Id.* 385 F. 3d at 777 (“He might have offered specifics on how well-known the name ‘Survivor’ still is today as the identifier of a rock band, but he did not.”). Here, Petitioner’s internet printouts should not be considered substitutes for actual evidence pertaining to the strength of the alleged mark. The lack of evidence pertaining to the alleged strength of Petitioner’s mark favors a finding of no likelihood of confusion.

b. The evidence does not establish similarity of the goods and services at issue.

Petitioner admits that “[v]ideo games and music are not directly competitive.” Petitioner’s br., p. 10. Petitioner claims, however, that “reasonable buyers of the computer game are likely to assume an affiliation, endorsement or sponsorship of the game by Petitioner” (*id.*), yet Petitioner offers no evidence to support this claim. A reasonable buyer may, in certain circumstances, be likely to assume affiliation, sponsorship, or endorsement when a mark is well known or famous. Here, however, there is no evidence about the strength of Petitioner’s mark and no evidence that consumers of Ubisoft’s goods are even aware of Petitioner’s mark such that

use of a mark on admittedly non-competitive goods is likely to cause confusion. As recognized in *Sullivan v. CBS*, a rock band “might enjoy strong protection for [its] mark against aspiring rock bands or musical groups, but ... [it] would have only weak or nonexistent protection outside that particular niche.” *Sullivan*, 385 F.3d at 777.

To support its claim that purchasers are likely to assume that Petitioner has licensed or endorsed Respondent’s video games, Petitioner argues that its mark has been in use for “nearly 30 years” and cites to an internet printout from Wikipedia. Petitioner’s brief, p. 10; Petitioner’s Notice of Reliance, Ex. 11. However, there is no testimony or probative evidence about the length of time Petitioner’s mark has purportedly been in use. While Petitioner may be arguing that likelihood of confusion is greater when a plaintiff’s mark is strong and well known, there is no evidence of that nature in this proceeding.

Petitioner seems to argue that because music is included in video games, and because some third-party registrations cover video games and the associated music, that necessarily music and video games are related. It simply cannot be the case that music is considered related to every product with which it is used such as movies and television shows. Indeed, as the *Sullivan v. CBS* case shows, use the mark SURVIVOR in connection with music from a television series is not likely to be confused with the music of the rock band SURVIVOR. *Sullivan*, 385 F.3d at 778 (“[I]t is not as if the Band’s CDs are identical to the Series’ CDs; they are not.”).

Even the third-party registrations on which Petitioner relies do not show that software games and electronic game software are related to audio video recording featuring music and artistic performances and entertainment, namely, live performances by a musical band. Registrations that cover a wide range of goods and services, like many of those on which

Petitioner relies, are less likely to suggest that goods within the identification may emanate from single source. *See, e.g.*, Registration Nos. 4,702,943; 4,726,271; 4,726,793; 4,733,968; 4,737,486; 4,750,424; 4,750,441; 4,754,933; 4,758,465; 4,766,817; 4,767,015; 4,767,459; 4,702,348; 4,705,413; 4,722,290; 4,726,114; 4,624,985; 4,635,297; 4,651,354; 4,663,842; 4,683,619; 4,690,693; 4,691,632; 4,698,436; 4,574,299; 4,616,577; 4,623,592; 4,675,437; 4,683,619; 4,687,008; 4,754,050; 4,766,687; 4,188,770; and 4,677,281. *See also In re Mucky Duck Mustard Co.*, 6 USPQ2d 1467, 1470 n. 6 (TTAB 1998); *Hi-Country Foods Corp. v. Hi Country Beef Jerky*, 4 USPQ2d 1169 (TTAB 1987) (dismissing opposition to register HI-COUNTRY and Design for jerky and sausage based on prior registration for HI-COUNTRY for fruit juices).

Beyond relying on many registrations that cover a wide range of goods and services, many of the third-party registrations have no probative value as to the alleged relatedness of software games and electronic game software, on the one hand, and audio video recording featuring music and artistic performances and entertainment, namely, live performances by a musical band, on the other. For example, a number of the registrations reference audio and video files, but there is no indication that the audio and video files are music files: Registration No. 4,767,442 (“downloadable audio and video files featuring sports and stunt exhibitions and inspirational messages”); Registration No. 4,708,380 (“Downloadable image file containing artwork, text, audio, video, games and Internet Web links relating to sporting and cultural activities”); Registration No. 4,712,062 (“Digital media, namely, pre-recorded video cassettes, digital video discs, digital versatile discs, downloadable audio and video recordings”); Registration No. 4,677,371 (“children’s entertainment computer software featuring audio sound recordings and interactive electronic books”); Registration No. 4,687,376 (“Audio discs

featuring and [sic] artistic performances”); Registration No. 4,687,708 (“Downloadable audio files, multimedia files, text files, e-mails, written documents, audio materials, video material and games featuring information in the form of downloadable educational/training communications in the field of building a video game and mobile gaming business”); and Registration No. 4,757,574 (“downloadable multimedia file containing artwork, text, audio, video, games, and Internet web links relating to football exhibitions”).

A number of registrations reference music related files, but there is no indication that the goods are recordings that actually feature music; rather music is referenced in a laundry list of content: Registration No. 4,608,468 (“Digital media, namely, CDs, DVDs, downloadable audio and video files featuring educational lessons, animation, digital books, artwork, crafts, coloring pages, games, flash cards, puzzles, sing-a-long activities, stories and cartoons for children”); Registration No. 4,077,193 (“CD Rom and DVD Rom discs featuring entertainment content in the nature of video games, video game hints, video game facts, music, and stories”); Registration No. 4,455,146 (“Downloadable digital materials, namely, ring tones, wallpapers, screensavers, digital music files, and graphics, videos, films, multimedia files, live action programs, motion pictures, and animation in the field of video games and computer games”); Registration No. 4,309,637² (“CD Rom and DVD Rom discs featuring entertainment content in the nature of video games, video game hints, video game facts, music and stories”); and Registration No. 4,496,484 (“downloadable music and sound files for games”). The fact that digital media or a video game might feature music does not mean that video games and music are related. Those registrations do not establish that software games and electronic games are related to recordings that *feature* music and artistic performance or live performances of a musical band.

² Petitioner includes this registration twice on Appendix A to its brief.

In at least seven of the third-party registrations, the reference to music-related goods has been deleted. *See* Registration Nos. 2,884,262; 2,862,803; 2,386,284; 2,640,728; 2,789,179; 2,938,745; and 2,810,705. As such, those cannot be probative of relatedness of the goods. And one registration does not cover game software, rather “computer software programs for editing photography and graphics.” *See* Registration No. 4,750,793.

As for the registrations that do list some form of a computer game and recordings featuring music, they are not accompanied by any evidence that the marks in the registrations are actually in use or that consumers have been exposed to them. *See Smith Brothers Mfg. Co. v. Stone Mfg. Co.*, 476 F.2d 1004, 177 USPQ 462 (CCPA 1973) (“But in the absence of any evidence showing the *extent of use* of any of such marks or whether any of them are now in *use*, they provide no basis for saying that marks so registered have had, or may have, any effect at all on the public mind so as to have a bearing on likelihood of confusion.”). As such, these registrations do not establish that consumers are likely to associate electronic game software and musical recordings offered under the same mark as coming from the same source.

Petitioner claims that “[i]n the instant proceeding one is able to reasonably conclude that music products like Petitioner’s music sound and video recordings are indeed related to the computer/video games marketed by Respondent.” Petitioner’s br., p. 13. However, Petitioner failed to come forward with any evidence that consumers actually consider such products to be related. To prevail, Petitioner must do more than posit a claimed reasonable conclusion.

c. The trade channels do not establish likelihood of confusion.

While the trade channels may be presumed to overlap for certain goods, there is no probative evidence that purchasers of Petitioner’s music, which Petitioner characterizes as a punk rock band from the late 1970s (Petitioner’s br., p. 5), overlap with the purchasers of Ubisoft’s software games. The fact that two parties’ products may be available on Amazon.com

should not be probative on the issue of overlapping trade channels given the breadth of products available on Amazon.com.

Moreover, with respect to Ubisoft's "software games that are downloadable from a remote computer site," there is no evidence, including Petitioner's registration, to demonstrate that Petitioner's goods are distributed via downloads. As such, as to at least a portion of Ubisoft's goods, there is nothing to demonstrate that the trade channels overlap.

Petitioner references customer overlap and the conditions under which purchases are made, but the record is completely devoid of any evidence on these factors. Petitioner has not established that channels of trade, the customers at issue, or conditions of purchase favor likelihood of confusion.

d. Lack of actual confusion shows that confusion is not likely.

A lack of actual confusion when there has been an opportunity for actual confusion is probative of no likelihood of confusion. *Citigroup Inc. v. Capital City Bank Group, Inc.*, 94 USPQ2d 1645, 1660 (TTAB 2010) ("for the absence of actual confusion to be probative, there must have been a reasonable opportunity for confusion to have occurred"). Here, according to Petitioner, its mark and Ubisoft's mark show up in the same search results when "black flag video" is searched. Petitioner's Notice of Reliance, Ex. 7. Yet, there is no evidence of actual confusion. Moreover, Ubisoft's BLACK FLAG mark is used in connection with a highly successful video game franchise. Ubisoft's Notice of Reliance, Exs. 1-12. The lack of actual confusion in light of ample opportunity for it is telling that confusion is not likely.

Ubisoft respectfully submits that Petitioner has not satisfied its burden of establishing likelihood of confusion.

II. Petitioner Did Not Submit Evidence or Argument In Support of Its Claim Under Section 2(a).

The Petition to Cancel includes a claim for false suggestion of a connection under Section 2(a) of the Lanham Act. However, Petitioner did not raise any arguments or cite to any claimed evidence in support of that Section 2(a) claim. As such, Ubisoft respectfully requests that Petitioner's claim under Section 2(a) of the Lanham Act also be dismissed.

CONCLUSION

Petitioner has not carried its burden of demonstrating likelihood of confusion. Ubisoft, therefore, respectfully requests that the Board dismiss the Petition to Cancel.

STINSON LEONARD STREET LLP

Dated: February 25, 2016

By: /Joel D. Leviton/

Joel D. Leviton
150 South Fifth Street, Suite 2300
Minneapolis, MN 55402
Telephone: 612.335.1500
joel.leviton@stinson.com

**ATTORNEYS FOR
UBISOFT ENTERTAINMENT**

CERTIFICATE OF SERVICE

The undersigned hereby certifies that a true and correct copy of the foregoing REGISTRANT'S RESPONSE TO PETITIONER'S TRIAL BRIEF was served on February 25, 2016, upon the following attorney for SST Records, Inc. by First Class Mail:

CHERYL L. HODGSON
HODGSON LEGAL
401 WILSHIRE BLVD, 12TH FLOOR PENTHOUSE
SANTA MONICA, CA 90401
UNITED STATES

Dated: February 25, 2016

/Joel D. Leviton/
Joel D. Leviton